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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,150	10/26/2001	Hung T. Nguyen	01-621	3566

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EXAMINER
MEONSKE, TONIA L

ART UNIT	PAPER NUMBER
2183	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/066,150	NGUYEN, HUNG T.
	Examiner	Art Unit	
	Tonia L. Meonske	2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 April 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a)   A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 1, 3, 6, 7, 8, 10, 13, 14, 15, 17, and 20 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Leung et al, US Patent 5,784,603, in view of Arizono US Patent

4,910,664.

3.   Claims 2, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leung

et al, US Patent 5,784,603, in view of Arizono US Patent 4,910,664, and Bogin et al., US Patent

5,835,435.

4.   Claims 4, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Leung et al, US Patent 5,784,603, in view of Arizono US Patent 4,910,664, and Chi, US Patent

6,243,807.

5.   Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Leung et al, US Patent 5,784,603, in view of Arizono US Patent 4,910,664, and Tokuume, US

Patent 4,965,722.

6.   The rejections are respectfully maintained and incorporated by reference as set forth in

the last office action, mailed on December 10, 2004.

Response to Arguments

7.   Applicant's arguments filed April 19, 2005 have been fully considered but they are not

persuasive.

On pages 6 and 7, Applicant argues in essence:

"First addressing the element of preventing prefetch outside of the loop, the Examiner states in paragraph 9 of the office action that Arizono, column 3, lines 10-67 and column 5, lines 43-54 teach, "The prefetch counter is reset to the loop-beginning address each time the prefetch counter equals the loop-ending address, thereby preventing said prefetch circuitry from prefetching instructions outside of said loop until said loop completes processing." However, column 5, line 64 through column 6, line 2, and FIGURE 5, state 4, teach that because the instruction bus is 16 bits wide, a byte fetch may result in the fetch of an additional byte past the end of the loop, which is then discarded when the prefetch counter is rest to the beginning of the loop. Thus, Arizono does not prevent the prefetch circuitry from prefetching instructions "outside of said loop until said loop completes execution," and Arizono fails to teach this limitation."

However, Arizono has taught thereby preventing said prefetch circuitry from prefetching

instructions outside of said loop until said loop completes processing. Applicant cited

column 5, line 64 through column 6, line 2, however Applicant is directed to 3

paragraphs after this citation at column 6, lines 40-44, where one byte prefetching is

described. Prefetching one byte instead of a plurality of bytes eliminates the fetch of an

additional byte past the end of the loop. Therefore, Arizono has in fact taught preventing

said prefetch circuitry from prefetching instructions outside of said loop until said loop

completes processing (column 6, lines 40-44). Therefore this argument is moot.

8.   On pages 7 and 8, Applicant argues in essence:

"In reinstating a validity of instructions, at best Arizono teaches the reinstatement of the validity of instructions in the abstract sense, i.e., returning to the top of the loop in the computational algorithm. Such a teaching is trivial and well known to those skilled in the art. An element of Claims 1,8, and 15 is the specific reinstatement of the validity of instructions residing in the instruction cache to obviate the need to fetch these instructions again ("...reinstates a validity of said fetched instructions..."). Nowhere is this limitation taught or suggested by Arizono."

However, Applicant is arguing a feature of the invention not specifically stated in the

claim language, which is improper. Claimed subject matter, not the specification, is the

measure of invention. Limitations in the specification cannot be read into the claims for

the purpose of avoiding the prior art. In re Self, 213 USPQ 1,5 (CCPA 1982); In re

Priest, 199 USPQ 11,15 (CCPA 1978).

> *"It is the claims that measure the invention." SRI Int'l v. Matshshita Elec. Corp.,*
> *775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc).*

> *"The invention disclosed in Hiniker's written description may be outstanding in*
> *its field, but the name of the game is the claim." In re Hiniker Co., 47 USPQ2d*
> *1523, 1529 (Fed. Cir. 1998).*

> *"[A]s an initial matter, the PTO applies to the verbiage of the proposed claims*
> *the broadest reasonable meaning of the words in their ordinary usage as they*
> *would be understood by one of ordinary skill in the art, taking into account*
> *whatever enlightenment by way of definitions or otherwise that may be afforded*
> *by the written description contained in the applicant's specification." In re*
> *Morris, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).*

> *"limitations appearing in the specification will not be read into the claims, and*
> *... interpreting what is meant by a word in a claim 'is not to be confused with*
> *adding an extraneous limitation appearing in the specification, which is*
> *improper'." Intervet Am., v. Kee-Vet Labs., 12 USPQ2d 1474, 1476 (Fed. Cir.*
> *1989)(citation omitted).*

> *"it is entirely proper to use the specification to interpret what the patentee meant*
> *by a word or phrase in the claim, ... this is not to be confused with adding an*
> *extraneous limitation appearing in the specification, which is improper. By*
> *'extraneous,' we mean a limitation read into a claim from the specification wholly*
> *apart from any need to interpret ... particular words or phrases in the claim." In*
> *re Paulsen, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citation omitted).*

In this case, Applicant has not claimed the specific reinstatement of the validity of

instructions residing in the instruction cache to obviate the need to fetch these

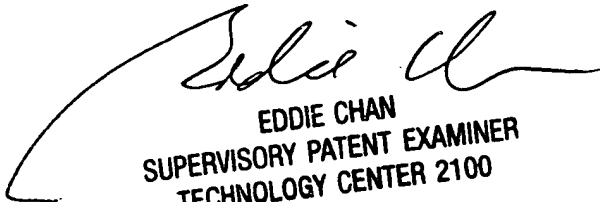instructions again. If Applicant would like specific limitations read into the claims

Applicant should specifically claim those limitations. Further, as pointed out by

Applicant, Arizono has in fact taught reinstating a validity of instructions, i.e., returning

to the top of the loop in the computational algorithm. In Arizono, resetting the prefetch

counter to the loop-beginning address reinstates the validity of the prior instructions in

the loop (Column 3, lines 10-67, column 5, lines 43-54). Therefore this argument is

moot.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tonia L. Meonske whose telephone number is (571) 272-4170.

The examiner can normally be reached on Monday-Friday, 8-4:30.

10.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eddie P. Chan can be reached on (571) 272-4162. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

11.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tlm

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